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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/673,428	12/05/2000	Paul Lippens	CASM116373	8709

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EXAMINER

SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/01/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

CLD 16

Office Action Summary

Application No.

09/673,428

Applicant(s)

LIPPENS ET AL.

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) 19-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Repeated Rejections

1. The 35 U.S.C. 102 rejection of claims 1-5, 8, 10, 11, 14, 16, 18 and 33 as anticipated by Namikawa et al. is repeated for the reasons previously of record in Paper #14, Pages 2-3, Paragraph #2.
2. The 35 U.S.C. 103 rejection of claims 6 and 7 over Namikawa et al. in view of Chamberlain is repeated for the reasons previously of record in Paper #14, Pages 3-4, Paragraph #4.
3. The 35 U.S.C. 103 rejection of claims 9, 12, 13, 15 and 17 over Namikawa et al. in view of Pettigrew et al. is repeated for the reasons previously of record in Paper #14, Pages 4-5, Paragraph #5.

Response to Arguments

4. Applicant's arguments filed September 22, 2003 have been fully considered but they are not persuasive. Applicant's argue that "Namikawa et al. does not disclose that soft magnetic materials can have their magnetic properties affected by embossing such that they can be detected externally." However, it is to be pointed out in claim 1 that the recitation "whereby the embossed layer affects the magnetic properties of the soft-magnetic layer and the effects are detectable externally of the security element" is a "whereby" statement and it has been held that the functional "whereby" statement does not define any structure and accordingly can not serve

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to distinguish. In re Mason, 114 USPQ 127, 44 CCPA 937 (1957). Therefore, the recitation is not given any patentable weight.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., "a security element suitable for machine verification by detecting the magnetic properties of a soft-magnetic layer, which are determined by **an underlying micro-embossing**") are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Furthermore, Applicant's argue that "Namikawa et al. discloses a hard magnetic layer, not a soft magnetic layer" However, it is to be pointed out that the magnetic layer in Namikawa et al. contains an alloy containing cobalt, iron, silicon and boron (see col. 8, lines 66 and 67). Therefore, it is a soft magnetic layer. Applicant further argues that "the use of an optical diffraction effect is not taught or even remotely disclosed in Namikawa et al." However, it is to be pointed out in Namikawa et al. that there is an embossed layer having an embossed pattern of a particular shape (Fig. 10, E1 and E2) which creates a variation of the surface. Therefore, an optical diffraction effect will be produced when light hits the element.

Conclusion

5. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703)605-4297. The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.


Catherine Simone
Examiner
Art Unit 1772
November 19, 2003


HAROLD PYON
SUPERVISORY PATENT EXAMINER
1772

11/25/03